BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The opinion of the District Court was rendered orally at the conclusion of the trial, and is reported in 48 U. S. P. Q. 59, and will also be found beginning at page 286 of the record.

The opinion of the Court of Appeals for the Seventh Circuit is reported in 122 F. (2d) 306, and will also be found beginning at page 674 of the record.

Jurisdiction.

The grounds of jurisdiction are:

1. The date of the judgment to be reviewed is July 22, 1941; Petition for Rehearing denied September 12, 1941.
2. The judgment was rendered in a civil action brought under the patent statutes to determine the issues of validity and infringement of Letters Patent of invention.
3. The statute under which jurisdiction is invoked is 240(a) of the Judicial Code, 28 U. S. C. A. 347, as amended by the Act of February 13, 1925.
4. Cases believed to sustain the jurisdiction are:

Mackay Radio & Telegraph Company v. *Radio Corporation of America,* 306 U. S. 86.

Schriber-Schroth Co. v. *Cleveland Trust Co.,* 305 U. S. 47.

Paramount Publix Theaters v. *American Tri-Ergon Corp.,* 294 U. S. 477.

Statement.

The facts are sufficiently stated in the petition.

Specification of Errors.

The errors which Petitioners will urge, if the petition for certiorari is granted, are that the Circuit Court of Appeals for the Seventh Circuit erred:

1. in sustaining Martin patent No. 2,115,642 as valid.
2. in reading into Martin Claim 5, by implication, a limitation which it does not contain in order to save it from anticipation by the prior art.
3. in failing to invalidate Martin Claims 1, 5, 7 and 11 as being broader than even the alleged combination which the Court of Appeals found to be inventive.
4. in failing to invalidate Claims 1, 5, 7, 8, 9, 10 and 11 of the Martin patent as wanting in invention, and as being for unpatentable aggregations.

Summary of Argument.

The points of argument follow the reasons relied upon for the grant of a writ of certiorari, and are stated on page 7 of the petition, as well as in the index hereto. For the sake of brevity, they are omitted at this point.

POINT 1.

The Court of Appeals for the Seventh Circuit has sustained as valid a patent against a defendant (Petitioner Allied) which was theretofore the largest supplier of manufacturer's type electric plugs in the United States, whereby the users of such plugs have been deprived of substantially one-third of their previous supply (at least 15,000,000 plugs per year) with the result that an acute shortage of plugs has ensued, wherefore the issues presented between the parties in this cause are vital to the industry as a whole.

The extremely large volume of Petitioner Allied's business, prior to the grant of injunction in this case, has caused such injunction to affect the entire industry throughout the United States.

An acute shortage of manufacturer's type plugs has resulted from the grant of injunction in this case and has actually caused the curtailment of the production of electrical appliances in general simply because of inability to procure attachment plugs for them. These circumstances render the present case of peculiar importance to manufacturers throughout the country.

Since this single case does directly affect not only the entire plug industry, but also the related industry of electrical appliance manufacture, certiorari should here be granted:

Mackay Radio & Telegraph Company v. *Radio Corporation of America*, 306 U. S. 86.

Schriber-Schroth Co. v. *Cleveland Trust Co.*, 305 U. S. 47.

Paramount Publix Theaters v. *American Tri-Ergon Corp.*, 294 U. S. 477.

POINT 2.

The Court of Appeals for the Seventh Circuit has, in order to sustain a patent claim, read into such claim by implication an element which it does not in fact contain, though the inclusion of such element was requisite to distinguish the claim even in words, much less in substance, from the prior art. This holding is untenable because it is in direct conflict with the applicable decisions of this Court.

The Court of Appeals below selected Claim 5 of the Martin patent as typical of the broad group of claims in suit from that patent (see opinion R. 674). It is apparent upon its face that Claim 5 is a very broad claim.* As construed by the Court of Appeals it is broad enough to cover any plug in which the blades are mounted by driving them into holes in a plug body. Obviously, it is doubtful at the outset that there could, at this late date, be any invention in such a concept.

The Court of Appeals below said in its opinion as to Claim 5:

> "With respect to Claim 5 of the Martin patent, defendants contend that it does not specify a central bore in the plug body. This is quite true, but we do not understand that each claim must describe every feature set forth in the other claims and in the specification, and in construing any claim it is to be done in view of the device of the character described in the specification . . . The reference to the specification is not for the purpose of broadening the claims, but it is only permitted for the purpose of explaining them, and to give a clear perspective of the de-

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* Claim 5 reads: "An electrical fitting comprising a body of non-frangible insulating material having a face and two spaced holes extending inwardly from the face, and metallic members having prongs forced into the holes, the sides of the prongs having laterally extending projections which engage the walls of the holes and resist removal."

> vice to which the claim is to be applied. Hence, we think claim 5 does contemplate a central bore in the plug body because it is ever-present in the device described in the specification."

The Court of Appeals below thus, by its construction of this broad claim, read into it an element which it does not contain. Furthermore, *the inclusion of that element was vital to save the claim from anticipation* for, without it, the claim reads squarely on even such an old device as that shown in the 1912 British patent of Day, No. 14,306 (R. 597). Even if the claim had included the element in question it would still have lacked invention over the art, for it was notoriously old to provide a plug body in which the electric cord entered through a central bore. *In any event, the claim is obviously and admittedly silent as to the element in question which would be necessary to distinguish it from the prior art even in words, much less in substance.*

This Court has repeatedly and expressly condemned precisely the type of claim interpretation in which the Court of Appeals below indulged in order to save Claim 5: *McCarty* v. *Lehigh R. Co.*, 160 U. S. 110, 116; *White* v. *Dunbar*, 119 U. S. 47, 52; *Minerals Separation* v. *Butte & S. Min. Co.*, 250 U. S. 336, 347. In the *Lehigh* case just cited, this Court said:

> "It is suggested, however, that this feature may be read into the claims for the purpose of sustaining the patent. While this may be done with a view of showing the connection in which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement."

In other words, the Court of Appeals below has, in the present case, done precisely and exactly what this Court has explicitly said it knows of no principle of law to support.

POINT 3.

The Court of Appeals for the Seventh Circuit has sustained as valid certain patent claims upon the ground that the patentee has invented a certain three-part plug (as distinguished from prior art plugs composed of five parts) despite the fact that the very claims in question are broad enough to, and were intended to, cover a five-part plug; wherefore said holding is untenable, being in direct conflict with the applicable decisions of this Court.

As the major and only basis expressed in the opinion of the Court of Appeals below for finding patentable subject matter in the Martin patent, the Court below said:

> "In other words, he produces the same result in a more efficient and facile manner by making *three* of those old elements accomplish the same result as *five* or more had theretofore done."

The "three" parts of the Martin plug in question are (one) a plug body, and (two and three) a pair of blades driven into recesses in the plug body in such manner as not only to wedge the blades themselves in place, but also to hold the ends of the wires in contact with the blades.

The "five" parts of the prior art plugs (see, for example, British patent No. 14,306 of Day at R. 597 and discussed in the opinion of the Court of Appeals below) are the same three elements, namely, (one) a plug body, and (two and three) a pair of blades driven into recesses in the plug body, *plus* (four and five) two screw parts for attaching the wires to the blades. In other words, it is the addition of two screw parts for attaching the wires to the blades which makes the total number of parts add up to five instead of three.

But the broad group of claims of Martin, which the Court below sustained along with a narrower group of claims, is not limited to three parts but is, instead, broad

enough to cover precisely the five-part structure of the prior art in which two additional screw parts are used to attach the wires to the blades. As to this, the Court of Appeals below itself has said in its opinion:

> "In discussing the claims of this patent, defendants classify them into two groups, and we shall so treat them. They classify Claims 1, 5, 7 and 11 as the first group *because they make no reference to any particular form of wire attachment to the blades, and relate solely to means for mounting the blades in the plug body structures which they define.* They select Claim 5 as typical of this group."

Since the group of broad claims noted above (Claims 1, 5, 7 and 11) are *not* limited to any particular form of wire attachment to the blades, they are obviously broad enough to cover the five-part arrangement of the prior art in which extra attachment screws are provided for that purpose. Further evidence, if any be needed, that this broad group of Martin claims is intended to, and does, cover a five-part plug (*i.e.*, one having, in addition to the plug body and pair of blades, a pair of screw parts for wire attachment), is afforded by the Benander patent No. 2,099,555 of record (R. 573) and referred to in the opinion of the Court of Appeals below. As noted in the opinion below, Martin was in interference in the Patent Office with Benander as to Martin's Claim 5. Therefore, Claim 5 had to be, and was, construed by the Patent Office as broad enough to cover the Benander plug. But Benander shows a *five-part* plug with screws for attaching the wires to the blades and nowhere even suggests a three-part plug.

It will thus be seen that the Court of Appeals below has validated Martin's group of broad claims on the ground that Martin was the first to produce a three-element plug as contrasted with the five-element plugs of the prior art, despite the fact that this particular group of claims from the Martin patent is broad enough to, and

is intended to, cover a five-element plug, as well as a three-element plug. Such a disregard of the scope of claims of a patent is in plain contravention to the applicable decisions of this Court: *White* v. *Dunbar*, 119 U. S. 47, 52; and *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U. S. 364, 369.

POINT 4.

The Court of Appeals for the Seventh Circuit has sustained as valid a patent for an alleged invention which is unpatentably aggregational on its face, thereby rendering a decision which is untenable because it is in direct conflict with the applicable decisions of this Court.

As pointed out above, the Court of Appeals below predicated its finding of invention in the Martin patent on the ground that they believed Martin to be the first to have produced a so-called "three-element plug," that is to say, a plug consisting solely of a plug body and two blades, the blades being so fashioned that they retain themselves in place upon being driven into the plug body, and also at the same time wedge the wire ends in place so as to secure attachment of the wires to the blades. Even assuming, for the sake of argument, that Martin was the first to produce a three-element plug, as distinguished from a five-element type which was admittedly old in the prior art, it is our contention that this analysis in numbering is arbitrary and proceeds on a false premise; that in such event Martin's real contribution was a two-part (not a three-part) structure, namely, a blade and a base for supporting the blade and attaching a wire to it; *and that having claimed a three-part combination rather than his two-part combination, his patent is void as a matter of law.* More specifically, respondent in effect asserts, and the Court of Appeals below has agreed, that he was the first

to drive a connector blade into a preformed hole in an insulator base (to hold the blade in place on the base) and at the same time wedge the bare end of a wire in the hole in the base by the blade itself (to thereby fasten the wire to the blade without the use of a separate screw or the like for the purpose).

That being the case, it is clear that there are only two, not three, parts in the combination, viz: a blade and an insulating support or base. *But Martin did not claim that.* He arbitrarily included "two" blades in his aggregative claims, thereby making a total of three parts. We say the number of blades is "arbitrary" because the art is replete with instances of plugs of this type in which one, two, three, four and more blades are used. The number is determined simply and solely by the number of wires in the circuit to which the plug is attached, *not* by any new coaction of the parts in the plug which makes two blades significant as compared to any other number.

If petitioners made a three-blade Martin plug, respondent would be the first to cry "infringer" and "mere colorable evasion," and yet the Court of Appeals below has permitted these arbitrarily limited and therefore aggregational claims to stand. The point is important not only because the Martin claims are bad as a matter of law, including as they do an arbitrary aggregation of parts which does not constitute the true invention if any, but also, because of their inclusion, respondent has succeeded in obscuring the true pertinence of the prior art.

Patent claims aggregatively adding to a combination arbitrarily selected additional parts have been frequently condemned in the decisions of this Court: *Lincoln Engineering Co.* v. *Stewart Warner Corp.*, 303 U. S. 545, 549; *Bassick Mfg. Co.* v. *Hollingshead Co.*, 298 U. S. 415, 425.

Conclusion.

Wherefore, petitioners earnestly pray that the petition for writ of certiorari be granted, the case be reviewed, and the decree of the Court of Appeals for the Seventh Circuit finding validity for Martin patent No. 2,115,642 be reversed.

Respectfully submitted,

C. PAUL PARKER,
Counsel for Petitioners.